Supreme Court, U.S.
FILED

164 (1)

10-126 JUL 22 2010

No. 10-

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IN THE

Supreme Court of the United States

MEDIA TECHNOLOGIES LICENSING, LLC and ADRIAN GLUCK,

Petitioners,

v.

THE UPPER DECK COMPANY, THE UPPER DECK COMPANY, LLC, UPPER DECK DISTRIBUTION & SALES COMPANY, UPPER DECK DISTRIBUTION & SALES COMPANY, LLC. and PLAYOFF CORPORATION,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether the same standard should govern the obviousness determination of patents in the non-technical arts as patents in the technical arts.

2. Whether the Federal Circuit erred by failing to apply in its obviousness analysis of a non-technical patent this Court's precedent that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

3. Whether this Court's precedent that a patent can be proved invalid as "obvious to try" when "there are a finite number of identified, predictable solutions" requires (1) merely that the number of solutions be "not infinite" (*e.g.* one million potential solutions) as the Federal Circuit held in this case; or alternatively, (2) that the number of solutions be relatively small or easily traversed (as the Federal Circuit has held in other cases). *KSR Int'l Co.*, 550 U.S. at 421.

PARTIES TO THE PROCEEDINGS

Pursuant to Rule 14.1(b), the parties here and in the proceeding in the U.S. Court of Appeals for the Federal Circuit are listed. Petitioners here and appellants below are Media Technologies Licensing, LLC and Adrian Gluck. Respondents here and appellees below are the Upper Deck Company, the Upper Deck Company, LLC, the Upper Deck Distribution & Sales Company, Upper Deck Distribution & Sales Company, LLC, and Playoff Corporation.

RULE 29.6 CORPORATE DISCLOSURE STATEMENT

Media Technologies Licensing, LLC has no parent companies and no publicly held company owns ten percent or more of its stock.

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The opinion of the U.S. Court of Appeals for the Federal Circuit (App., *infra*, 1a-19a) is reported at *Media Techs. Licensing, LLC v. Upper Deck Co.*, 596 F.3d 1334 (Fed. Cir., 2010). The opinion of the U.S. District Court for the Central District of California (App., *infra*, 20a-24a) is unreported.

JURISDICTION

The decision of the U.S. Court of Appeals for the Federal Circuit, affirming the opinion of the U.S. District Court for the Central District of California (Order Granting Summary Judgment No. 3: Patents Invalid on Obviousness Grounds), was handed down on March 1, 2010. A timely petition for rehearing was denied on April 23, 2010. This court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. § 103(a).

INTRODUCTION

This Court last addressed the obviousness standard of 35 U.S.C. § 103 in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). As relevant here, the Court in *KSR* set forth the following principles:

> 1. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . . [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.
>
> * * *
>
> 2. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. . . . In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

Id. at 418-419; 421.

This case raises two fundamental issues concerning these *KSR* principles that this Court must review.

(1) Does the principle set forth in *KSR* – that a patent claim cannot be invalidated based on a finding "that each of its elements was, independently, known in the art" without identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" – apply equally to non-technical arts (*i.e.*, arts where a layman can readily grasp the technology in contrast to arts like chemistry, mechanics, or electrical engineering where specialized expertise is required)?

This case demonstrates that the Federal Circuit believes it need not apply this Court's precedent in a case like this, where the technology is non-technical. (The Patents relate to sports trading cards). As Judge Rader forcefully argued in dissent:

> Lurking just beneath the surface of the court's blindness to the underlying facts supporting non-obviousness is a bias against the non-technical arts. . . . [M]any individuals invest vast energies, efforts, and earnings to advance these nontechnical fields of human endeavor. Those investments deserve the same protection as any other advances. The incentives for improvement and the protection of invention apply as well to the creator of a new hair-extension design as to a researcher pursuing a cure for cancer. In either case, the PTO and this court are charged with

> assessing the invention disclosure to determine its worthiness to receive a valuable, but temporally limited, exclusive right.

App., *infra*, 12a.

(2) Does the principle set forth in *KSR* that a patent can be invalidated as "obvious to try" only if "there are a finite number of identified, predictable solutions" mean that obviousness is shown simply because the number of potential solutions to the problem was "not infinite" (as the Federal Circuit held in this case) or does it mean that the number of potential solutions must be "small or easily traversed" (as the Federal Circuit has held in cases involving more technical arts)?

In this case, the Federal Circuit reasoned that because "content solutions are significantly limited by the theme and physical confines of the [trading] card," the number of potential solutions to creating an appealing trading card is necessarily "not infinite" and therefore obvious to try. App., *infra*, 8a. The court thus improperly interpreted *KSR's* "finite number" touchstone as meaning "not infinite" (no matter how large the number), when this Court clearly used the phrase "finite number of identified, predictable solutions" to mean a relatively small number of solutions that could be easily traversed. The Federal Circuit's holding in this case would render any invention in the trading card industry (and any other field where there is some physical or thematic limit) invalid as obvious to try. This holding is thus contrary to this Court's precedent.

Review of these two issues is necessary to bring the Federal Circuit back in line with the obviousness framework this Court set forth in *KSR*.

FACTUAL STATEMENT

A. THE INVENTION.

By the early 1980s, the central need in the trading card industry was for a new type of card that would have peculiar appeal. Such a card could serve as a "chase card" in a trading card series and be randomly inserted in sealed packs of cards to drive consumer demand.

By 1994, inventor Adrian Gluck was working on a number of media technologies, including new types of trading cards. Gluck also became aware of a problem in the sports memorabilia industry. For decades, people collected sports memorabilia, such as game-used baseballs, basketballs, or jerseys. Authenticating memorabilia had been a central – and costly – concern for collectors. Because of the limited supply of authentic memorabilia, by the 1980s the price of such items placed them beyond the reach of youngsters and average income families.

In a stroke of insight, Gluck saw a way of addressing these unmet needs in both the trading card and the memorabilia industry. He proposed to take a valuable memorabilia item used by a sports figure and cut it up into many tiny pieces. This would of course destroy all inherent indicia of authenticity (e.g., number on the jersey, patches, labels, markings, style, size) and would result in pieces of "of otherwise unidentifiable material."

He would then take a piece of the memorabilia item and attach it to a sports trading card. Gluck coined the term "Memorabilia Card" for his invention.

B. THE RESULTS.

Gluck applied for a patent in December 1994, and then submitted his invention to each company in the sports trading card industry. They each rejected Gluck's proposal. About a year later, however, Defendant Upper Deck experimented with the Memorabilia Card for one series of football trading cards. The record shows that Memorabilia Cards were initially met with skepticism by most trading card collectors; many were outraged and appalled at the idea of destroying valuable sports memorabilia; numerous articles and commentators predicted the failure of Memorabilia Cards; and other trading card companies such as Fleer and Topps were openly skeptical of the concept.

Despite this profound initial skepticism, the commercial response soon turned overwhelmingly positive with the "product flying out of" stores.

It turned out that Gluck's invention produced an unexpected synergy. The combination of trading cards with a piece of a memorabilia item had the unexpected result that consumers automatically accepted as authentic a piece of otherwise unidentifiable material. Because of the credibility and authenticity already associated with the 90-year old trading card industry, the pieces of memorabilia do not require authentication from an independent third party. The piece of memorabilia adopts the aura of authentication from the

medium that delivers it, the trading card. The trading cards self-authenticate the pieces of memorabilia, thereby enabling authenticated memorabilia to be mass produced. The memorabilia card had a self-authenticating characteristic that could not have been anticipated and would not have arisen with other types of carriers such as stationery, certificates, or other pieces of paper. As an unexpected result, rather than simply destroying the value of the memorabilia and the trading card, the combination created inherent value and (1) could be affordable, and (2) could allow more consumers to obtain memorabilia.

Within a short time, the Memorabilia Card dominated the trading card industry. Memorabilia Cards were used by every manufacturer and were the core of virtually every trading card series. The invention produced sales of hundreds of millions of trading cards and generated tens of millions in profits.

The Defendants in this case have admitted that Memorabilia Cards had become "necessary to competition within the sports trading card market." They call the invention "revolutionary." And the leading trade publication named the Memorabilia Card the "most unique" trading card product of the century.

C. THE PATENT CLAIMS.

Two patents with the same specification are asserted. The asserted claims of U.S. Patent No. 5,803,501 ("'501 patent") generally cover a piece of a memorabilia item attached to a trading card and placed on the card near where the actual item would typically

appear in an image depicting the item's relationship to the person shown on the card. The asserted claims of U.S. Patent No. 6,142,532 ("'532 patent") focus on particular types of memorabilia. They require attaching a tiny piece of a particular sports memorabilia item (baseball, bat, football, etc) or sports or entertainment clothing. For example, a small sliver of an actual baseball bat used by a professional baseball player may be attached to the trading card where the player's bat appears in the image.

The asserted claims were all subject to reexamination proceedings filed by the Defendants before the United States Patent and Trademark Office ("PTO"). The PTO considered each of the prior art references presented by Defendants in this litigation as well as each of Defendants' arguments for obviousness. The PTO confirmed all claims of the '501 patent in their original form and confirmed all asserted claims of the '532 patent as rewritten in independent form.

D. THE PRIOR ART.

1. Monroe.

The Monroe reference is a trading card with a picture of Marilyn Monroe and a diamond attached to the card. This reference is the only trading card prior art asserted by Defendants and it does not contain a piece of memorabilia. A memorabilia item was defined as "an object valued for its connection with historical events, culture, or entertainment." A diamond owned and worn by Marilyn Monroe would be an example of a

memorabilia item. But the diamond attached to the Monroe reference had *no connection* with Marilyn Monroe. Likewise, the raw material from which the diamond was taken had no connection with Monroe and no value to a collector of Monroe memorabilia. Accordingly, it was not "valued for its connection" and was not a memorabilia item.

Moreover, the claimed invention calls for a "piece" of a memorabilia item or a "portion, but not the entirety," of an authentic memorabilia item. The very key to the invention requires taking a functional item, such as a ball or bat, and turning it into non-functional scrap. By contrast, the diamond in the Monroe reference is a fully functional and complete diamond, not a "piece" of a diamond. No one, including the manufacturer of the Monroe reference, would describe the diamond on the reference as a "piece" of a diamond. Conversely, no one would describe a tiny piece of a bat or a jersey as a "bat" or "jersey."

The Monroe reference does nothing to suggest cutting up pieces of valuable memorabilia.

2. Whittier.

The Whittier reference consists of a cut up piece of a sheet that was purportedly slept on by one of the Beatles and that is attached to a copy of a letter on Whittier Hotel stationery that declares it to be authentic.

The Whittier reference has nothing to do with trading cards, and nothing about it suggests that

marrying a piece of memorabilia and a trading card would have any particular benefits. The Whittier experiment was, by all appearances, a failure and it never inspired any other attempts to cut up authentic memorabilia and attach them to something. The idea of attaching a piece of memorabilia to stationery originated in 1964 and, more than 40 years later, there is no sign that it was ever tried again (much less that it had the amazing success of the memorabilia card). In particular, the Whittier experiment did nothing to mitigate counterfeiting, and the principal version proffered by Defendants is an admitted counterfeit that does not contain an authentic piece of memorabilia.

Consequently, the Whittier Hotel reference did not solve the problem that cutting a valuable memorabilia into pieces turns it into "unidentifiable material," and erases all inherent indicia of authenticity. Most significantly, nothing about the Whittier Hotel experiment suggested that a potential solution was to attach a piece of memorabilia to a trading card.

3. Eckert.

The Eckert reference is an example of a "prayer card" or "holy card." It is paper stock on which appears a picture of a Capuchin Friar named Stephen Eckert and a piece of fabric that purports to be clothing belonging to him. A holy card is a piece of advertising or religious marketing material that is given away to try to get people familiar with a particular religious figure. It is used to promote the cause of the person pictured on the card, such that the person may become eligible for sainthood.

This reference does not teach or suggest using a trading card (it has none of the key features of a trading card). Nor is the attached piece of fabric a piece of a "memorabilia item." The record shows that no special collector value was associated with Father Eckert's robe and as a result, there would be no concern about destroying such an item. Nor was the robe an implement used by a "popular sports or entertainment figure or during a memorable event." The purpose of a holy card is to help someone who is unknown become better known.

The Eckert reference did nothing to teach that cutting up valuable memorabilia and marrying it to a trading card would be a good idea, or to expose the (then unpredicted) benefits of that marriage.

4. James Dean.

The James Dean reference is a novelty greeting card with a small square of attached fabric. It contains a headline "in the style of a headline from the National Enquirer" that reads "Rebel's Cause Lives: Ecstatic Discovery! James Dean's Jeans!" and "Actually contains a piece of Jimmy's Clothing." It contains a small square of denim and, as the designer of the card put it: "On the card, it was made clear that this was a novelty item; the words 'this card made in jest' appear prominently on the reverse of the card." The record shows that anyone looking at the card would immediately realize that this was a joke, would not think that they were acquiring something of value, and would not be motivated to destroy an actual memorabilia item. The very source of the joke for this greeting card is the absurd idea –

worthy of the National Enquirer – of cutting up a valuable memorabilia item.

This reference lacks two key ingredients of the invention: a trading card and a piece of a memorabilia item.

E. SYNERGY AND UNPREDICTED BENEFITS.

Attaching a cut up piece of memorabilia to a trading card produced synergies and unpredicted benefits.

Before Gluck achieved his invention, those of ordinary skill in the art understood that cutting up a valuable memorabilia item would "destroy[] the value of the memorabilia" by erasing the indicia of authenticity. A whole baseball jersey worn by, for example, Babe Ruth, includes many indicia of authenticity – the number on the jersey, patches, labels, markings, style, size, and perhaps grass or dirt stains. The constellation of those indicia work together to give someone confidence that the item is authentic. But if that jersey were cut up into tiny squares, that constellation would be obliterated. One would be left with "a piece of otherwise unidentifiable material" that could be easily counterfeited.

Moreover, these indicia of authenticity contribute to the item's intrinsic appeal. By holding a complete jersey, bat, or ball, a fan can readily imagine the ball player using it in action. But a small swatch of fabric or sliver of wood would appear to lose all such qualities of stirring the imagination.

The prior art references asserted by Defendants reinforced this very point. Because cutting up a piece of memorabilia so obviously destroys its value, this concept was the source of the joke in the James Dean reference. The Whittier reference, which consisted of attaching cut up bed sheet pieces to a copy of a letter, was an idea tried in 1964 that promptly failed. The attached piece of stationery did nothing to convey authenticity or mitigate counterfeiting.

Consequently, at the time of the invention it was unpredicted (and completely unexpected) that attaching a tiny piece of memorabilia to a trading card would be sufficient to assure its authenticity. As one expert concluded, "The combination of trading cards with a piece of a memorabilia item had the unexpected result that consumers automatically accepted as authentic a piece of otherwise unidentifiable material." Moreover, "authentication of each individual piece of memorabilia by an independent third party, which has previously been a cost-restrictive factor in distributing memorabilia, was no longer needed . . . thereby enabling authenticated memorabilia to be mass produced."

It was also unpredicted that if a small piece of cloth, leather, or wood is adhered to a trading card adjacent to an image of the ballplayer – near where the actual item might appear in a photograph of the player using the item – then this combination would be sufficient to meaningfully stir the imagination in a manner similar to the whole memorabilia article. But in fact, a fan can see the three-dimensional texture of the fabric, leather, or wood, and can "have a visceral experience by touching an object used or worn by that hero," which thus generates "an emotional response."

As an Upper Deck executive put it, "there's this synergy that we've created from combining . . . the trading card and someone's jersey. The combination produces trading cards and memorabilia items that are of far greater value than the original. For example, if a game-used football jersey sells for $1,500, it can be cut up into hundreds of one-inch squares and a single one-inch square of that same used jersey on a card is worth $550.

F. THE FEDERAL CIRCUIT'S OPINION.

1. Majority Opinion.

The panel majority of the Federal Circuit affirmed the district court's finding that the Patents are invalid as obvious under 35 U.S.C. § 103(a) based on a combination of the Monroe, Whittier, Eckert and James Dean prior art. In doing so, the majority never acknowledged this Court's precedent in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418-19 (2007), that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* at 418. Instead of analyzing "whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue," *id.*, the majority simply walks through various combinations of the prior art that, it believes, render the claims obvious:

> Media Tech argues that Monroe differs from claim 1 of '501 patent because Monroe's diamond is neither "a memorabilia item" nor a "piece," as recited by the claim. Based on

> the construction of "memorabilia," "an object valued for its connection with historical events, culture, or entertainment," Monroe's diamond is memorabilia. As for the "complete" vs. "piece" distinction, even if Monroe's diamond is not a "piece," Whittier, Eckert, and Dean teach using "a piece" of memorabilia.
>
> Media Tech maintains that claim 6 of the '501 patent differs from Whittier because Whittier does not teach "a card." Monroe, however, is a card. It also asserts that Dean differs from claim 24 of the '532 patent because it does not teach using memorabilia. Dean does teach using memorabilia. It may fail to teach "authentic memorabilia," but "authentic[ity]" is taught by Whittier and Eckert. Claims 23 and 25 through 29 of the '532 patent would have been obvious for the same reasons presented for claim 24 because they differ only in their recitation of a specific type of memorabilia piece (e.g., baseball hat, baseball, etc.).

App., *infra*, 6a-7a.

The majority picks and chooses material satisfying the claim elements from among the prior art. Nowhere in this discussion does the panel majority ever address the fundamental question of whether one of skill in the art would have been aware of any reason to combine Monroe with any one of Whittier, Eckert, or Dean to obtain claim 1 of the '501 patent; would have been aware of any reason to combine Whittier and Monroe to obtain

claim 6 of the '501 patent; or would have been aware of any reason to combine Dean and either Whittier or Eckert to obtain claim 24 of the '532 patent (as well as claims 23 and 25 through 29). The panel majority instead appears to assume that because these elements were separately available in the prior art, the claims in question are obvious.

The majority further reasoned, pursuant to *KSR*'s "obvious to try" approach to obviousness, that the number of possible solutions to the problem Gluck's invention addressed – *i.e.*, developing a new trading card with a particular appeal – was "not infinite" (and the invention was therefore obvious) because "the presentation and content characteristics of trading cards are not infinite." App., *infra*, 8a. The majority made no attempt to identify or enumerate the possible solutions or assess whether they could be easily traversed.

2. Judge Rader's Dissent.

In dissent, Judge Rader correctly observed that "the record is dubious at best – particularly at this summary judgment stage – in suggesting that a person with skill in the art would even consider the four prior art references relied on by defendants, much less combine them." App., *infra*, 18a.

In particular, Judge Rader observed that (1) there was "not a single reference in over a century of history [of baseball cards that] disclosed attaching a cut-up piece of memorabilia item to a baseball card," *id.*, 13a; (2) "all the prior art suggested that the value of an item

of memorabilia hinged on its condition," *id.*; (3) there was considerable evidence of initial skepticism at the concept behind the invention, *id.*; (4) there was considerable evidence of copying by defendants, unexpected results, and commercial success, and praise throughout the industry – including one industry publication dubbing the invention "ground-breaking," *id.*, 13a-15a; and (5) there was an opinion from plaintiff's expert explaining in detail why a person of ordinary skill in the art would not have thought to make the claimed invention, *id.*, 18a.

REASONS FOR GRANTING THE PETITION

1. The Panel's Decision Raises a Question of Exceptional Importance Concerning Obviousness in the Non-Technical Arts.

This case requires review because, as Judge Rader emphasized in dissent, the majority decision applies a different standard for determining obviousness for the non-technical arts than the standard employed for more technical arts. Neither Congress nor this Court has ever articulated a divergent standard for determining obviousness based on the technical nature of the patent.

In the technical arts, the Federal Circuit has consistently followed this Court's precedent in *KSR* and addressed the question of whether a reason existed to use and combine the asserted prior art. To take but one example, in the context of chemical compounds, the Federal Circuit requires the identification of a lead compound – a compound possessing characteristics desirable to one of skill in the art that make it a "natural

choice" for further development, free from teaching away. *Eisai Co., Ltd. v. Dr. Reddy's Labs, Ltd.*, 533 F.3d 1353, 1358 (Fed. Cir. 2008); *Altana Pharma AG v. Teva Pharma. USA, Inc.*, 566 F.3d 999, 1008 (Fed. Cir. 2009). Only then does the Court even proceed to conduct a rigorous consideration of reason to combine. *See also Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008) ("[S]ome kind of motivation must be shown from some source . . . why a person of ordinary skill would have thought of either combining two or more references or modifying one to achieve the patented method.") (analyzing obviousness of medical diagnostic tools under *KSR*) (internal quotes omitted).

In this case, where the subject matter was not technical, the consideration given by the panel majority to Defendants' obviousness case is nowhere near as scrupulous as that employed for other fields. Again by way of example, if Monroe and Whittier were the names of chemical compounds, this Court would never uphold a grant of summary judgment of obviousness on the reasoning, without more, that "claim 6 of the '501 patent differs from Whittier because Whittier does not teach 'a card.' Monroe, however, is a card." Instead, the Court would consider whether Whittier would be a "natural choice" for one designing trading cards to start with, and then would ask whether some reason was suggested in the prior art to combine Whittier and Monroe. The Court would also address the evidence of teaching away that Judge Rader discussed in his dissent. The standards applied to a non-technical field should be no less rigorous.

Again, Judge Rader noted this tenor to the majority's decision, stating:

> Relying on wholly irrelevant prior art and ignoring significant indicia of non obviousness, this court substitutes its judgment on patentability for that of a jury. Lurking just beneath the surface of this court's blindness to the underlying facts supporting non-obviousness is a bias against non-technical arts. No doubt, the invention of the transistor or of the polio vaccine came from more scientific fields and contributed more to the welfare of humanity. This court, however, cannot overlook that many individuals invest vast energies, efforts, and earnings to advance these non-technical fields of human endeavor. Those investments deserve the same protection as any other advances. The incentives for improvement and the protection of invention apply as well to the creator of a new hair-extension design as to a researcher pursuing a cure for cancer. In either case, the PTO and this court are charged with assessing the invention disclosure to determine its worthiness to receive a valuable, but temporally limited, exclusive right.
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> * * *
>
> Plaintiff also proffered an expert, Henry Taylor, with credentials similar to those of Mr. Kelly but opposite conclusions on obviousness. Why, on summary judgment,

> would this court give Mr. Kelly's opinions more weight than those of Mr. Taylor? Is this an indication that this court views this field of art and this invention as unworthy of the full processes of law?

App., *infra*, 12a, 18a.

Identifying a reason to combine the prior art, as the Federal Circuit failed to do here, is in fact all the more important in the non-technical arts, as this is where the danger of hindsight bias is at its greatest. The difference between an impossible problem and a trivial problem is usually whether you know the solution. But knowing the solution (e.g., by reading the patent) does not mean that the solution was obvious before it was known. *See McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2002) ("The genius of invention is often a combination of known elements which in hindsight seems preordained. . . . When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting.") (internal citations omitted); *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

> Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

(internal citations omitted).

35 U.S.C. § 103 draws no distinction based on the technical nature of the invention. And, as Judge Rader argues, this is for good reason – non-technical inventions advance society forward just like technical inventions. Review of this case is necessary to make clear that the non-technical arts must be afforded the same protection under the patent laws as the technical arts.

2. The Court's "Obvious to Try" Approach In *KSR* Has Led To Inconsistent Interpretations By The Federal Circuit.

Review of this case is also necessary to resolve the Federal Circuit's inconsistent application of the "obvious to try" approach to obviousness articulated by the Court in *KSR*.

In *KSR*, this Court held that "the Court of Appeals [ ] conclude[d], in error, that a patent claim cannot be proved obvious merely by showing that the combination of elements was '[o]bvious to try.'" *Id.* at 421 (internal citation omitted). The Court then laid out the framework for determining whether a patent claim is "obvious to try:"

> When there is a design need or market pressure to solve a problem and there are a *finite number of identified, predictable solutions*, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a

> combination was obvious to try might show that it was obvious under § 103.

Id. at 421 (emphasis added) .

In the wake of *KSR*, the Federal Circuit has interpreted the requisite "finite number" of possible solutions in contradictory ways. In several instances, the Federal Circuit has interpreted the "finite" number of solutions to mean a small number of solutions, each of which can be readily traversed. *See Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008) ("the passage above in *KSR* posits a situation with a finite, and in the context of the art, *small or easily traversed, number of options*") (emphasis added); *Bayer Schering Pharma AG v. Barr Labs., Inc.*, 575 F.3d 1341, 1347 (Fed. Cir. 2009) ("our interpretation [is] that *KSR* requires the number of options to be 'small or easily traversed'") (quoting *Ortho-McNeil*, 520 F.3d at 1364). This limited interpretation of "finite" reflects the rationale that "where a defendant merely throws metaphorical darts at a board filled with combinatorial prior art possibilities, courts should not succumb to hindsight claims of obviousness." *In re Kubin*, 561 F.3d 1351, 1359-60 (Fed. Cir. 2009).

In this case, by contrast, the Federal Circuit took the *opposite* approach and held that the "finite number" prerequisite is satisfied so long as the number of possible solutions is less than "infinite" – no matter how large the number and no matter how unlikely it would have been to traverse all of the possibilities:

> Regarding the infinite number of identified and unpredictable solutions, the presentation

> and content of trading cards are not infinite. These characteristics are limited by the cards' physical characteristics. . . . Content solutions are significantly limited by the theme and physical confines of the card, and the finite number of available solutions were predictable.

App., *infra*, 8a.

In other words, the Federal Circuit reasoned that because the number of potential solutions was "not infinite" that number is "finite." (For example, because one million is not an infinite number, one million possible solutions is "finite.") And because the number of solutions is "finite" then it must fit within the framework that when "there are a finite number of identified, predictable solutions," a combination is "obvious to try." *KSR Int'l Co.*, 550 U.S. at 421.

This reasoning merits review of this case for the following reasons:

(1) The "obvious to try" approach is one of the most commonly asserted approaches to obviousness. Since *KSR*, it has been mentioned in more than 80 district court and Federal Circuit opinions.

(2) The Federal Circuit's interpretation of "finite" in this case is contrary to the holdings of other Federal Circuit panels that "a finite number" of identified solutions does not mean anything that is "not infinite" but instead means a "small or easily traversed, number of options." *Ortho-McNeil*, 520 F.3d at 1364; *Bayer Schering*, 575 F.3d at 1347 (same).

(3) Interpreting a "finite" number of solutions to simply mean "not infinite" renders nearly every combination patent "obvious to try." This Court has recognized that "claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *KSR Int'l Co.*, 550 U.S. at 418-19. What is known or possible in a particular field is rarely, if ever, infinite. However, this in no way means that a new and useful invention cannot emerge from that field.

One need look no further than the facts of this case to illustrate this point. By the panel majority's logic, because "content solutions are significantly limited by the theme and physical confines of the [trading] card" and therefore "not infinite," App., *infra*, 8a, there can be no inventions worthy of a patent in the trading card industry. However, when discussing his own work in the field, Defendants' expert emphasized the "unique techniques . . . outside the realm of trading cards" that his "creative team" adopted by "think[ing] outside the box." Outside the box, creative thinking can certainly result in new products that are not "obvious to try." This is precisely the sort of activity that the Patent Act is designed to encourage.

CONCLUSION

For the above and foregoing reasons, Petitioners respectfully request the issuance of writ of certiorari to the United States Court of Appeals for the Federal Circuit.

Respectfully submitted,

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